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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/258,609 | 02/26/1999 | HIROSHI KOBATA | EPC-009 | 4096 |

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| EXAMINER | |
|---|---|
| KANG, PAUL H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2141 | |

DATE MAILED: 02/12/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/258,609 | KOBATA ET AL. | |
| | Examiner | Art Unit | |
| | Paul H Kang | 2141 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 February 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., US Pat. No. 5,790,790 in view of Ishibashi et al., EP 0 812 100 A2.

3. As to claims 1, 13 and 16, Smith discloses an apparatus for delivering a document to a receiving station over a network, comprising (See Smith, col. 2, lines 20-31):

a server system connected to the network and storing digital information received over the network (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10); and

*the apparatus* connected to the network and transmitting a notification to the receiving system, the notification signifying that the sending system is transmitting the digital information over the network to the server system and that the digital information may be accessible by the receiving system at the server system (Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

However, Smith does not explicitly teach that the sending system transmits both the digital information and a notification to the receiving system. In the same field of endeavor,

Ishibashi teaches a system for transmitting from a sending machine a notification to the recipient as well as the digital information to a storage server (See Ishibashi, Abstract and page 2, lines 40-59 and page 6, lines 6-27 and page 6, line 27 – page 7, line 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of transmitting both a notification and digital information as taught by Ishibashi into the system of Smith for the purpose of providing an efficient and immediate notification and message transmission system.

4. As to claims 2 and 23, Smith-Ishibashi teach the server system receives the digital information from the sending system (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

5. As to claims 5-7, Smith-Ishibashi teach a storage device in communication with the server and wherein the server system stores the digital information at an address location of the storage device, and wherein the server system includes a page providing a path by which the receiving system can access the digital information at the address location, wherein the notification has a resource locator which addresses the page on the server system (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

6. As to claims 8 and 27, Smith-Ishibashi teach the page requests valid authentication information from the receiving system before granting access to the digital information (Smith,

lines 17-49).

7. As to claims 9-11, Smith-Ishibashi teach a page which provides access to a graphical window describing contents of the digital information and resource locators reference multiple locations in the storage device to access the data structure using the unique identifiers (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

8. As to claims 17 and 19, Smith-Ishibashi teach transmitting the digital information from the server system to the receiving system in response to a request from the receiving system and executing a server-side software through which the receiving system can obtain access to the digital information (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

9. As to claim 3-4 , 12, 14-15 and 24-26, Smith-Ishibashi teach a second server system in communication with the sending system and the first server system, wherein the first server system receives the digital information from the sending system via the second server system, acting logically as a single server system (See Smith, col. 3, line 47-62).

10. As to claims 18 and 28-29, Smith-Ishibashi teach the invention substantially as claimed. However, Smith-Ishibashi do not explicitly teach the step of tracking the digital information in real-time, confirming that the receiving system has completely received the digital information and notifying the sending system when the receiving system starts using the digital information.

Official notice is taken (see MPEP 2144.03) that tracking message transmission was well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a method of confirming that a message was completely received into the system of Smith-Ishibashi for the purpose of increasing data transmission reliability.

11. As to claims 20 and 21, Smith-Ishibashi teach the step of maintaining a page on the server system through which the receiving system can obtain access to the digital information and the notification includes the resource locator for accessing the page (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

12. As to claim 22, Smith-Ishibashi teaches the step of concurrently sending a notification and digital information (notification to the recipient from the sender that a message is being transmitted to a server is sent "almost simultaneous" with the transmission of the message. Ishibashi, page 2, lines 42-59).

13. As to claims 30 and 31, Smith-Ishibashi teaches the invention substantially as claimed. However Smith-Ishibashi does not explicitly teach the step of canceling delivery after sending the digital information.

Official notice is taken (see MPEP 2144.03) that canceling a message was as well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a step to cancel a message

anytime after it has been sent into the system of Smith-Ishibashi for the purpose of enhancing the control of the data transmission.

14. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith-Ishibashi, as applied above, further in view of Romrell, US Pat. No. 6,396,805 B2.

15. As to claim 32, Smith-Ishibashi teaches the invention substantially as claimed. However Smith-Ishibashi does not explicitly teach the step of restarting a connection after an interruption at the point of interruption.

In the same field of endeavor, Romrell teaches a system and method for recovering from interruptions of data transfer retransmission after interruption starts at the point of interruption (see Romrell, claim 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated method to restart a connection at the point of interruption, as taught by Romrell, into the system of Smith-Ishibashi for the purpose of increasing system fault tolerance.

***Response to Arguments***

Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection. The Applicants argued in substance that:

A) the prior art of record teaches that a notification is transmitted after tranmission of the message to the server. The Applicant cites page 4, line 56 – page 5, line 35 of Ishibashi.

As to point A, Ishibashi teaches that a notification to the recipient from the sender is sent "almost simultaneous" with the transmission of the message to the server. See Ishibashi, page 2, lines 42-59.

B) Applicant requested the examiner to provide support for the Official Notice taken in rejecting claim 32. A new grounds of rejection has been applied to this claim.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul H Kang
Examiner
Art Unit 2141